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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,442	03/28/2005	Raffaello Mazzanti	163-617	6182
47888 7590 02/11/2009 HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER LIGHTFOOT, ELENA TSOY				
ART UNIT 1792		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,442

**Applicant(s)**

MAZZANTI, RAFFAELLO

**Examiner**

Elena Tsoy Lightfoot

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) 24-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### ***Response to Amendment***

Amendment filed on December 15, 2008 has been entered. Claims 24-46 are pending in the application. Claims 24-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

1. Objection to claim 46 because of the informalities has been withdrawn due to amendment.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Rejection of claim 46 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

Art Unit: 1792

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-46 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 11, 15, 16, 19, 24 of copending Application No. 10/482,538 in view of Rosenkranz et al (US 4339566) for the reasons of record set forth in the Office Action mailed on 8/13/2008.

This is a provisional obviousness-type double patenting rejection.

#### ***Claim Objections***

5. Claim 44 is objected to because of the following informalities: step B) is repeated twice. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 recites the limitation "said ceramic substrate" in line 4 in B) and in last line. There is insufficient antecedent basis for this limitation in the claim. For examining purposes the phrase was interpreted as "said flooring or lining material".

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Rejection of claims 44-45 under 35 U.S.C. 102(b) as being anticipated by Sokol (US 20020110643) has been withdrawn due to amendment.
10. Rejection of claims 44-45 under 35 U.S.C. 102(b) as being anticipated by Kuno (EP 393525) has been withdrawn due to amendment.
11. Rejection of claims 44-46 under 35 U.S.C. 102(b) as being anticipated by Desobry (US 5340701) has been withdrawn due to amendment.
12. Rejection of claims 44-46 under 35 U.S.C. 102(b) as being anticipated by Rosenkranz et al (US 4339566) has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sokol, as applied in previous Office Action, and further in view of Hayes et al (US 5705118).

As to flooring or lining material, Sokol teaches porous ceramic *construction* materials (See P3). Since Sokol does not limit teaching to particular materials, they would include any porous ceramic construction materials including porous ceramic flooring or lining material.

Sokol fails to teach removing the cured sealer on the surface ceramic material (Claim 44).

However, Hayes et al teaches that a porous ceramic material (See column 4, lines 4-45), e.g. refractory ceramic material (claimed ceramic lining) (See column 4, lines 30-31) or ceramic tile (See column 2, lines 20-21) may be produced by impregnating the material with e.g. a curable epoxy resin, curing the resin, then **polishing** the surface of impregnated ceramic material by **grinding-off** the cured resin (claimed removing the hardened layer) (See column 28, lines 12-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have produced ceramic construction materials of Sokol by **polishing** the surface of impregnated ceramic material by **grinding-off** the cured resin, as taught by Hayes et al, depending on particular use of a final product.

15. Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuno or Kuno in view of Curtiss et al, as applied in previous Office Action, and further in view of Hayes et al.

As to flooring or lining material, Since Kuno does not limit teaching to particular materials, they would include any porous ceramic construction materials including porous ceramic flooring or lining material.

Kuno fails to teach removing the cured sealer on the surface of flooring or lining material.

Hayes et al is applied here for the same reasons as above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have produced ceramic construction materials of Kuno/Kuno in view of Curtiss et al by **polishing** the surface of impregnated ceramic material by **grinding-off** the cured resin, as taught by Hayes et al, depending on particular use of a final product.

16. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desobry, as applied in previous Office Action, and further in view of Hayes et al.

As to flooring or lining material, Since Desobry does not limit teaching to particular materials, they would include any porous ceramic construction materials including porous ceramic flooring or lining material.

Desobry fails to teach removing the cured sealer on the surface of flooring or lining material.

Hayes et al is applied here for the same reasons as above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have produced ceramic construction materials of Desobry by **polishing** the surface of impregnated ceramic material by **grinding-off** the cured resin, as taught by Hayes et al, depending on particular use of a final product.

17. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenkranz, as applied in previous Office Action, and further et al in view of Hayes et al.

As to flooring or lining material, Since Rosenkranz et al does not limit teaching to particular materials, they would include any porous ceramic construction materials including porous ceramic flooring or lining material.

Rosenkranz et al fails to teach removing the cured sealer on the surface of flooring or lining material.

Hayes et al is applied here for the same reasons as above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have produced ceramic construction materials of Rosenkranz et al by **polishing** the surface of impregnated ceramic material by **grinding-off** the cured resin, as taught by Hayes et al, depending on particular use of a final product.

18. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over NL 7706352A in view of Nettekoven (US 5846237).

NL '352 discloses a process for protecting ceramic products such as **ceramic tiles** and natural stone **floor** and wall-covering materials from soiling comprises coating the product with a material which prevents the **ingress** of soiling matter and which can **readily be removed** together with the soiling matter after the ceramic products have been put in place or worked. The coating materials comprise natural or synthetic latex of an emulsion, dispersion or solution of a natural or synthetic resin (claimed hardenable composition). (See Abstract).

Obviously, the coating prevents the **ingress** of soiling matter by sealing pores of the ceramic tile; and obviously, the coating is formed by removing the solvent, i.e. by **drying**.

NL '352 fails to teach that the readily removable coating is colored. However, it is a common knowledge in the art to use colored removable coating to readily detect the presence of absence of the protective removable layer, as evidenced by Nettekoven. Nettekoven teaches that deterioration of colored sacrificial coating partly overlying undercoating of different color may



be readily detected when the color of the undercoating begins to show (See column 3, lines 9-13).

As to claim 46, it is well known in the art that the latex is based on solvent, typically water.

19. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abernethy et al (US 3,113,900) in view of Desobry or Rosenkranz et al.

Abernethy et al discloses a method for producing mosaic tile assemblies comprising applying a hardenable sealant composition that is widely known in the trade to the surface of tile to close the pores of the tile curing or drying said hardenable resin, and then *buffing* and *polishing* the cured or dried resin (claimed removing the hardened layer) coated tile (See column 3, lines 62-71).

Abernethy et al fails to teach that that a hardenable sealant composition is aqueous photopolymerizable colored composition.

Desobry teaches that a photocurable *aqueous* acrylic resin (See column 21, lines 25-27) comprising dyes or pigments (See column 21, line 33) is suitable for coating *ceramic* substrate (See column 22, lines 36-39). Rosenkranz et al teaches that a radiation curable aqueous acrylic resin (See column 8, lines 7-10) comprising dyes or pigments (See column 8, line 37) is suitable for coating *ceramic* substrate (See column 8, lines 11-12).

It is well settled that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have used a radiation curable aqueous acrylic resin of Desobry or Rosenkranz et al with the expectation of providing the desired sealed ceramic tile.

***Response to Arguments***

20. Applicant's arguments with respect to claims 44-46 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1792

February 10, 2009

/Elena Tsoy Lightfoot/